

## REMARKS

Applicants sincerely appreciate the thorough examination of the present application, as evidenced by the Office Action of October 15, 2008. Applicants particularly appreciate the reconsideration and withdrawal of the previous rejections of Claims 1-10. Applicants have carefully reviewed the newly cited reference by Lamb et al. and have amended the claims extensively to clarify their patentability. Applicants respectfully submit, for the reasons explained below, that the application is in condition for allowance, which is requested.

### A. Status of the Claims

Claims 2 and 9-10 stand rejected under 35 USC § 101 as directed to non-statutory subject matter. Office Action at 2.

Claims 1-10 stand rejected under 35 USC § 101 as lacking utility. Office Action at 2.

Claims 1-10 stand rejected under 35 USC § 102(b) as anticipated by over U.S.

Publication No. 20020037735 to Lamb et al. ("Lamb"). Office Action at 3.

Claims 1, 3 and 7-10 have been amended. Claims 4-5 have been cancelled.

### B. The Rejections under 35 USC § 101 Should Be Withdrawn

Claims 2 and 9-10 stand rejected under 35 USC § 101 as directed to non-statutory subject matter. Office Action at 2. In particular, the Office Action notes that paragraph [0006] of the Specification states that "[t]his invention includes a software product termed a Communication Module." Applicants respectfully note that the eligibility of a claim under 35 USC § 101 should be determined with reference to the claim itself. See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, USPTO Official Gazette, 22 November 2005 ("Interim Guidelines"), Section I.C. ("The claims define the property rights provided by a patent."). Applicants note that Claim 2 is directed to a method, while Claim 9 is directed to a system and Claim 10 is directed to a computer-readable medium; none is directed simply to "software." However, Applicants have amended paragraph [0006] of the specification to remove the phrase objected to by the Examiner.

Claims 1-10 stand rejected under 35 USC § 101 as lacking utility. Office Action at 2. In particular, the Office Action states that "[t]he Claims 1-10 recite manipulation of data with the statements of 'determination' and 'reconfiguration' but fail to recite a practical application (useful,

tangible and concrete result). Further, Claim 10 lacks the requirement under 101 guidelines of the module to be executed." Office Action at 2.

Applicants respectfully disagree that Claims 1-10 fail to recite a practical application that provides a useful, tangible and concrete result, at least because Claim 1 is directed to a method that involves significantly more than mere manipulation of data. For example, Claim 1 recites "transmitting a message from a communications module through a Voice-Over Internet Protocol communications network to an Internet Protocol communications device to determine if a signaling path to the Internet Protocol communications device exists in the Voice-Over Internet Protocol communications network," and "determining that the signaling path fails to exist in response to a failure to receive a response to the message from the Internet Protocol communications device." Furthermore, in response to determining that the signaling path fails to exist, the method according to Claim 1 recites "reconfiguring call routing information in a database of network routing instructions relating to the Internet Protocol communications device." That is, in the method of Claim 1, a database of network routing instructions is physically reconfigured in response to determining that the signaling path fails to exist. This practical application provides a useful, tangible and concrete result.

However, Applicants note that the "useful, tangible and concrete result test" was recently repudiated by the Federal Circuit. See In Re Bilski, \_\_\_ F.3d. \_\_\_, No. 2007-1130 (Fed. Cir. 2008), slip op. at 20 ("Therefore, we also conclude that the 'useful, concrete and tangible result' inquiry is inadequate and reaffirm the machine-or-transformation test outlined by the Supreme Court is the proper test to apply."). According to the "machine-or-transformation" test, a method claim is eligible for patent protection under 35 USC § 101 if the claim is tied to a particular machine or if the claim transforms a physical article into a different state or thing. In Re Bilski, slip op. at 24.

As Claim 1 is directed to a method that is both (1) tied to a particular machine, namely a communication server and a database of network routing instructions, and (2) that transforms the state of a physical article, namely by reconfiguring call routing information in the database of network routing instructions, Claim 1 is eligible for patent protection under 35 USC § 101 under the test set forth in In Re Bilski. Dependent Claims 2, 3 and 6 recite statutory subject matter at least based on the patent-eligibility of Claim 1.

Similarly, Claims 7 and 8 recite methods of providing communications services by a communications server that include similar recitations as the above-quoted recitations of Claim 1, while Claim 9 recites a system comprising a Communications Module stored in a memory device, and a processor communicating with the memory device, and Claim 10 recites a computer readable medium. In both cases, the system of Claim 9 and the article of manufacture of Claim 10 physically transform a database of network routing instructions in response to determining that a signaling path fails to exist. Claims 7-10 are therefore eligible for patent protection under 35 USC § 101.

C. The Rejections under 35 USC § 102 Should Be Withdrawn

Claim 1 has been amended to recite, inter alia, "reconfiguring call routing information in a database of network routing instructions relating to the Internet Protocol communications device in response to determining that the signaling path fails to exist based upon network-defined logic that specifies alternate routing destinations when any Internet Protocol communications device served by the communications server is not available" (emphasis added). Similar amendments have been made to Independent Claims 7-10. Thus, according to Claim 1, reconfiguring call routing information is performed based upon **network-defined logic** that specifies alternate routing destinations when **any** Internet Protocol communications device served by the communications server is not available. Applicants respectfully submit that these recitations are not taught or suggested by Lamb.

For example, Lamb Fig. 3 and associated text discloses a user agent 301 that resides in a telecommunications hosting server 203 and provides call processing services for an associated computer telephony equipment (CTE) 242. See Lamb, col. 27, lines 5-49. Lamb discloses that the user agent 301 is aware of the status of the user of the CTE 242, and can perform call processing based on that status. However, in contrast to the recitations of Claim 1, the call processing described by Lamb is performed based on user-defined logic, and not on "network-defined logic that specifies alternate routing destinations when any Internet Protocol communications device served by the communications server is not available," as recited in Claim 1. For example, Lamb describes the call processing function of the user agent 301 as follows:

The invention can provide the "smart processing" noted above in a number of ways as advanced calling services. For example, perhaps the user associated with the user agent 301 that received the call signaling message 230 had previously provided future status information to his or her associated user agent 301. The future status information may have indicated, for example, that the user will not be nearby the user telephony device 106 for a prescribed period of time. Rather, the user associated with the user agent 301 might have specified another user telephony device (e.g., a cell phone) where the user can be reached for a specific time period. In other words, one embodiment of the system of the invention allows a user to program, instruct or otherwise "tell" his or her associated user agent 301 (via the user agent interface 250) that he or she will be near another phone (e.g., reachable at another phone number) on the PSTN 101 for a specific time period. When the user agent 301 thus receives the call signaling message 230 containing the indication that a call connection is to be established with the second user (from the user telephony device 108 in use by the first user), the user agent 301 for the destination user (the second user) can return to the telecommunications network server 202-1 an identification of a different user telephony device where the second user can be reached. The telecommunications network server 202-1 can thus instruct the public phone switch 202-2 to place a call connection to the newly specified call destination identifier indicated in the returned call signaling message 230.

To this end, the system of the invention allows "smart routing" of calls based upon programmable user agents 301 that can be programmed by an associated user to "know" the whereabouts of the user at all times. The calls can either originate from the PSTN 101 as in the former example, or may originate from a user of a user agent interface 250 on the computer network 200 as in the first example. In either case, the user agent 301 can operate as a first contact point for a user such that the telecommunications hosting server 203 and/or the telecommunications network server 202-1 can communicate with a user agent 301 to determine how to handle calling information concerning a user associated with the user agent 301. The calling information may be an incoming call connection request, or may be a query as to the current status, whereabouts, activity or other information concerning a user associated with that user agent 301.

Lamb, col. 34, lines 24-67 (emphasis added). Accordingly, Lamb repeatedly describes that the user agent 301 can be programmed by a user to handle calls in a particular manner.

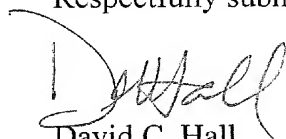
In contrast, embodiments of the invention enable reconfiguring call routing information in a database of network routing instructions relating to an Internet Protocol communications device based upon network-defined logic that specifies alternate routing destinations when any Internet Protocol communications device served by the communications server is not available. As explained in the Specification, "[t]hese network-defined logical instructions 32, for example, may specify that any further communications are automatically rerouted (or readdressed) to a subscriber's email address, a subscriber's home IP phone, a cellular phone, an archival storage

server, and/or any other alternate destination the service provider might desire." Specification, para. [0030]. Applicants therefore respectfully request reconsideration and allowance of Independent Claims 1 and 7-10. Dependent Claims 2, 3, and 4-6 are patentable at least based on their dependence from a patentable base claim.

### CONCLUSION

In light of the above remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the undersigned representative at the telephone number indicated below to discuss any outstanding issues relating to the allowability of the application.

Respectfully submitted,



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